REMARKS

This response is intended as a full and complete response to the non-final Office Action mailed July 6, 2007. In the Office Action, the Examiner notes that claims 1-12 are pending and rejected.

In view of both the amendments presented above and the following discussion, Applicants submit that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §§102 and 103. Thus, Applicants believe that all of the claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

I. 35 U.S.C. §102 Rejection of Claims 1-3, 6-7 and 9-12

The Examiner has rejected claims 1-3, 6-7 and 9-12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,422,674 to Hooper (Hooper). Applicants respectfully traverse the rejection.

Applicants' claim 1 recites:

> 1. Apparatus for producing a digital bitstream containing an interactive program guide for a digital information distribution system comprising:
> means for combining, in a frame synchronized manner, background imagery with at least one video sequence and at least one graphic containing program guide information to form a composited frame sequence; wherein the combining step further comprises:
> means for compositing, frame-by-frame, at least one video sequence onto said background imagery to form a background sequence; and
> means for compositing a plurality of program guide graphics onto said background sequence, where a different program guide graphic is composited onto said background sequence to form a plurality of program guide frame sequences that represent individual program guide pages; and
> means for encoding the composited frame sequence to compress information therein to form a digital bitstream. (Emphasis added).

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. Hooper fails to disclose each and every element of the claimed invention, as arranged in claim 1. Specifically, Hooper fails to teach or suggest at least a means for combining, in a frame synchronized manner, background imagery with at least one video sequence, as recited in claim 1. For example, in one embodiment, the Applicants' invention provides a novel compositing technique that enables full motion video to be positioned within an IPG and have the video seamlessly transition from one IPG page to another. (See e.g., Applicants' specification, p. 6, ll. 23-25). As a result promotional advertisements may be displayed on the IPG while a viewer is scrolling among multiple IPG pages.

In contrast, Hooper fails to teach or suggest the use of at least one video sequence with the background imagery. Hooper at best only teaches the user of still graphics, objects and text. (See Hooper, col. 7, ll. 14-23, 32-38, 58-68). Therefore, Hooper fails to anticipate because Hooper does not teach or suggest each and every one of the limitations of Applicants' invention, as recited in claim 1.

Independent claim 7 recites relevant limitations similar to those recited in independent claim 1. Accordingly, for at least the same reasons discussed above, independent claim 7 also is not anticipated by Hooper and are patentable under 35 U.S.C. §102. Furthermore, claims 2-3, 6 and 9-12 depend directly or indirectly from independent claims 1 and 7, while adding additional elements. Therefore, these dependent claims also are not anticipated by Hooper and are patentable under 35 U.S.C. §102 for at least the same reasons discussed above in regards to independent claims 1 and 7. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

II. 35 U.S.C. §103 Rejection of Claims 4-5 and 8

A. Claims 4 and 5

The Examiner has rejected claims 4 and 5 under 35 U.S.C. §103(a) as being unpatentable over Hooper. Applicants respectfully traverse the rejections.

These grounds of rejection apply only to dependent claims and are predicated on the validity of the rejection under 35 U.S.C. 102 given Hooper. Since the rejection under 35 U.S.C. 102 given Hooper has been overcome, as described hereinabove,

these grounds of rejection cannot be maintained. Therefore, these dependent claims also patentable under 35 U.S.C. §103 over Hooper alone or in combination with any additional references. Therefore, Applicants respectfully request that the Examiner's rejection of claims 4 and 5 be withdrawn.

B. Claim 8

The Examiner has rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Hooper in view of MacInnis (U.S. Patent No. 7,110,006, hereinafter "MacInnis"). Applicants respectfully traverse the rejections.

The Applicants respectfully submit that MacInnis is not a proper reference against the Applicants' invention as the Applicants' invention has an earlier priority date than that of MacInnis. The Applicants' invention claims its earliest priority to U.S. Patent Application serial number 09/201,528, filed on November 30, 1998. MacInnis claims its earliest priority date to November 9, 1999.

However, if the Examiner is relying on the fact that MacInnis claims priority to a provisional application that was filed on November 9, 1998, then the Examiner must apply the MacInnis provisional application as the prior art reference instead. Since a 111(a) application that claims priority to a provisional application does not have to recite the identical specification as that of the provisional application, the Examiner must provide prima facie evidence that the alleged teaching in the MacInnis reference has direct support in the MacInnis provisional application. Without such prima facie evidence, the Applicant respectfully submits that the MacInnis reference is not a proper prior art reference against Applicant's application.

Furthermore, these grounds of rejection apply only to dependent claims and are predicated on the validity of the rejection under 35 U.S.C. 102 given Hooper. Since the rejection under 35 U.S.C. 102 given Hooper has been overcome, as described hereinabove, these grounds of rejection cannot be maintained. Therefore, these dependent claims also patentable under 35 U.S.C. §103 over Hooper alone or in combination with any additional references. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

THE SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicants' disclosure than the primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

CONCLUSION

Thus, Applicants submit that none of the claims, presently in the application, are anticipated or obvious under the respective provisions of 35 U.S.C. §§102 and 103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Chin (Jimmy) B. Kim or Eamon J. Wall at (732) 530-9404, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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